



10 APR 2007

Wiggin and Dana LLP  
Attention: Patent Docketing  
One Century Tower, P.O. Box 1832  
New Haven, CT 06508-1832

In re Application of :  
JUSKEY et al. :  
U.S. Application No. 10/563,172 :  
PCT No.: PCT/US04/04676 :  
It. Filing Date: 17 February 2004 : DECISION ON PETITION  
Priority Date: 21 February 2003 :  
Attorney Docket No.: 102402-200 :  
For: LEAD FRAME WITH INCLUDED :  
PASSIVE DEVICES :

This decision is issued in response to applicants' "Petition for Filing by Other Than All the Inventors under 37 CFR 1.47(a)" filed 12 March 2007 to accept the application without the signature of joint-inventor, Lawrence R. Thompson.

### **BACKGROUND**

On 17 February 2004, applicants filed international application PCT/US04/04676, which claimed priority of an earlier application filed 21 February 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 21 August 2005.

On 30 December 2005, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; a preliminary amendment; and a petition under 37 CFR 1.137(b).<sup>1</sup>

On 10 January 2007, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 12 March 2007, applicants filed the present petition under 37 CFR 1.47(a).

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<sup>1</sup>Applicants' petition to revive under 37 CFR 1.137(b) was granted in a Decision on Petition dated 30 January 2007.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1) and (3) have been satisfied.

Regarding item (2) above, petitioner states that Lawrence R. Thompson has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that petitioner has not satisfied item (2) above, in that, the petitioner has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, drawings, and oath/declaration to Lawrence R. Thompson. The affidavit of Marty Kennedy states that she mailed, via Federal Express, a declaration and power of attorney on May 20, 2006. However,

petitioner fails to include evidence to demonstrate that the materials were received by the nonsigning inventor. Where the Office is being asked to accept the silence of the nonsigning inventor's as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant. Further, it is unclear from the present petition whether Lawrence R. Thompson has been presented with a complete copy of the application papers as required. The mailing of an oath and declaration is not considered a complete copy of the application papers.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, drawings and oath/declaration) were sent to Lawrence R. Thompson, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

Regarding item (4), section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, petitioner has filed a declaration executed by Frank J. Juskey that included an unsigned signature box identifying the nonsigning inventor. However, petitioner has not provided a declaration executed by the second inventor, David K. Lau. Therefore, item (4) has not been satisfied.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Lawrence R. Thompson under 37 CFR 1.47(a) at this time.

### **CONCLUSION**

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to:  
Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box

1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read "Anthony Smith", with a stylized flourish at the end.

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